

Appln. No. 10/032,330
Amdt. dated January 26, 2004
Reply to Office action of July 25, 2003

REMARKS

Claims 67 and 68 presently appear in this case. No claims have been allowed, although previously-appearing claims 23 and 25 have been indicated to be allowable if rewritten in independent form and without the non-elected species. The official action of July 25, 2003, has now been carefully studied. Reconsideration and allowance are hereby respectfully urged.

Briefly, the present invention relates to methods for enhancement of bone healing or for increasing bone density by the administration of a specified compound.

Claims 7-11 and 14-21 have been withdrawn from further consideration as being directed to a non-elected invention and species.

These claims have now been deleted, thus obviating this restriction requirement.

The examiner states that the declaration filed April 5, 2002, refers to application no. 09/458,491 in the section claiming benefit under 35 U.S.C. §120, but this application is not cited either in the Application Data Sheet or in the first sentence of the specification. The examiner states that, should applicant wish to include this application in any claim for priority, applicant should submit an amendment to their

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current claim for priority and, in addition, submit a petition under 37 C.F.R. §1.78.

Applicant hereby waives benefit of priority of U.S. application 09/458,491. Thus, no amendment to the current claim for priority is necessary, nor is any petition under 37 C.F.R. §1.78.

The examiner stated that the drawings are objected to because, in Figure 3A, "untreated" is misspelled. The examiner states that a proposed drawing correction or corrected drawings are required in reply to the official action to avoid abandonment of the application.

Attached hereto is a corrected copy of Figure 3A, thus obviating this objection.

The examiner has objected to the disclosure because of a number of informalities.

All of the informalities noted by the examiner have been addressed and corrected except for the deletion of the reference to a website. The examiner referred to MPEP §608.01. However MPEP §608.01 only objects to imbedded hyperlinks which are browser executable, i.e., are placed between the symbols "<>" or use the format "http://" followed by a URL address. In the present specification, neither form of embedded hyperlinks is present. Only the URL address is present, and this is permissible. There is nothing in the

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MPEP that states that web addresses are impermissible; only embedded hyperlinks are impermissible, and this part of the specification is not an embedded hyperlink as discussed above. Accordingly, reconsideration and withdrawal of this part of the rejection is respectfully urged.

Claims 42, 45, 47, 49-52, 59-62, 64 and 66 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

These claims have all been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application. Accordingly, this rejection has now been obviated.

Claims 39, 45, 47, 49-52, 54-57, 59-62 and 64-66 have been objected to because of informalities.

These claims have now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application. Thus, this rejection has now been obviated.

Claims 37, 39, 41-45, 47, 49-52, 54-57 and 59-62 have been provisionally rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over various claims of copending application no. 10/038,612.

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These claims have all now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application, thus obviating this rejection.

Claims 37, 39, 45 and 47 have been rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 1-9 of U.S. patent no. 6,174,993.

The rejected claims have all now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application. Thus, this rejection has now been obviated.

Claims 37, 39, 45 and 47 have been rejected under 35 U.S.C. §102(b) as being anticipated by Holmes.

These claims have all now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application. Accordingly, this rejection has now been obviated.

Claims 1, 2, 12, 13, 26, 31, 37, 39, 41, 43-45, 47, 49, 51, 52, 54, 56, 57, 59 and 61-66 have been rejected under 35 U.S.C. §102(b) as being anticipated by Liu.

All of the rejected claims have now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application. Accordingly, this rejection has now been obviated.

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Claims 1, 2, 12, 13, 26, 31, 37, 39, 41, 43-45, 47-49, 51, 52, 54, 56, 57, 59 and 61-66 have been rejected under 35 U.S.C. §102(b) as being anticipated by WO 96/32411.

All of the rejected claims have now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application. Accordingly, this rejection has now been obviated.

Claims 1, 2, 12, 13, 26-28, 31-33, 37, 39, 41, 43-45, 47-49, 51, 52, 54, 56, 57, 59 and 61-67 have been rejected under 35 U.S.C. §102(b) as being anticipated by Stuber.

All of the rejected claims have now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application, thus obviating this rejection.

Claims 1-4, 12, 13, 26-37, 39, 41, 43-45, 47, 49, 51, 52, 54, 56, 57, 59 and 61-67 have been rejected under 35 U.S.C. §102(b) as being anticipated by WO 98/53050.

All of the rejected claims have now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application. Accordingly, this rejection has now been obviated.

Claims 1, 5, 6, 12, 13, 26, 27, 29-32, 34, 37, 39, 41, 43-45, 47, 49, 51, 52, 54, 56, 57, 59 and 61-67 have been

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rejected under 35 U.S.C. §102(b) as being anticipated by WO 98/53051.

All of the rejected claims have now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application. Accordingly, this rejection has now been obviated.

Claims 1, 2, 5, 6, 12, 13, 22, 24, 26, 31, 37, 39, 41-45, 47, 49-52, 54-57 and 59-67 have been rejected under 35 U.S.C. §102(e) as being anticipated by Khosla in view of Ballard.

All of the rejected claims have now been deleted without prejudice toward the continuation of the prosecution thereof in a continuing application. Accordingly, this rejection has now been obviated.

Claims 23 and 25 have been objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims and if rewritten to omit the non-elected amino acid sequences. The examiner acknowledges that the prior art of record does not teach or suggest administering a compound having applicant's SEQ ID NO:21 in order to enhance bone healing or to increase bone density.

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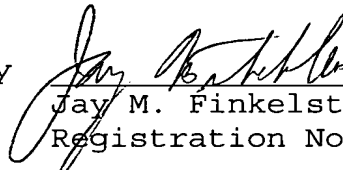
Claims 23 and 25 have now been rewritten in independent form as new claims 67 and 68. Furthermore, they are specifically directed to the use of SEQ ID NO:21. Accordingly, these claims should now be in condition for allowance.

It is submitted that all of the claims now present in the case clearly define over the references of record and fully comply with 35 U.S.C. §112. Reconsideration and allowance are, therefore, earnestly solicited.

Respectfully submitted,

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